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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,029	03/15/2004	Jose Francisco Gomez Insa	5724.092.00	6865

7590 01/16/2007  
Song K. Jung  
MCKENNA LONG & ALDRIDGE LLP  
1900 K Street, N.W.  
Washington, DC 20006

EXAMINER
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PLUMMER, ELIZABETH A

ART UNIT	PAPER NUMBER
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3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/800,029

Applicant(s)

GOMEZ INSA, JOSE FRANCISCO

Examiner

Elizabeth A. Plummer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-28 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/30/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Preliminary amendments received 05/17/2004 have been entered and considered. Claims 1-28 are pending. This is a first Office action on the merits for application serial number 10/800,029 filed 03/15/2004.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 13, claim 13 recites the limitation "opposite the second tab" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, it is assumed that claim 13 is intended to depend from claim 12 instead of claim 11.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 rejected under 35 U.S.C. 102(b) as being anticipated by Slater (US Patent 3,411,977).

- a. Regarding claim 1, Slater discloses a molding profile (12) for use between two building surfaces, comprising a foot (23) projecting from the upper body portion along a second axis of the molding profile, wherein the first axis and the second axis are substantially perpendicular (Figs. 1-3) and a first groove (Fig. 2, right of rib 31) extending into the first arm.
- b. Regarding claim 2, the first groove runs in a direction parallel to a third axis of the molding profile, the third axis being substantially perpendicular to the first and second axis (Figs. 1-3).
- c. Regarding claim 3, the molding profile further comprises a second groove (between shoulder 24 and the undersurface of the molding profile) extending into a side of the foot (23).
- d. Regarding claim 4, both the first arm and the second arm comprise an undersurface (Figs. 1-3).
- e. Regarding claim 5, at least a portion of the undersurface of the second arm is at an angle relative to the first axis (Figs. 1-3).
- f. Regarding claim 6, at least a portion of the undersurface of the second arm is substantially parallel to the first axis (tip of second arm, Figs. 1-3).
- g. Regarding claim 7, the substantially parallel portion is adjacent a distal end of the second arm (tip of second arm, Figs. 1-3).

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f. Regarding claim 8, the second groove comprises an upper surface and runs parallel to the third axis (Figs. 1-3).

g. Regarding claim 9, the upper surface of the second groove is flush with the undersurface of the first arm (Figs. 1-3).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 10, 11, 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfalt et al. (US Publication 2003/0159389).

a. Regarding claims 1 and 2, Kornfalt et al. discloses a molding profile (100,101,102,103) for use between two building surfaces, comprising an upper body portion having a first arm and a second arm extending in opposite along a first axis of the molding profile (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B), and a foot projecting from the upper body portion along a second axis of the molding profile, wherein the first axis and the second axis are substantially perpendicular (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B). Kornfalt et al. does not disclose a first groove extending into the first arm and running in a direction parallel to a third axis of the molding profile, the third axis being substantially perpendicular to the first and second axes. However, Kornfalt et al. does disclose a tab extending out of the first arm and running in a direction

parallel to a third axis of the molding profile, the third axis being substantially perpendicular to the first and second axes. The tab interlocks with a groove in a corresponding second molding profile, running in a direction parallel to a third axis of the molding profile. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to form a first groove extending into the first arm and running in a direction parallel to a third axis of the molding profile, as it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstien, 8 USPQ 167.

b. Regarding claim 10, the undersurface of the first arm is substantially parallel to the first axis of the molding profile (Figs. 5,6A, 10B, 11B, 12B, 14B).

c. Regarding claim 11, Kornfalt et al. discloses a molding profile assembly for use between floor surfaces, the molding profile assembly comprising a first molding profile (100,101,102,103) and a second molding profile (90,95,1000).

The first molding profile comprises an upper body having a first arm and a second arm extending along a first axis of the molding profile assembly, the first and second arms each having an undersurface (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B), a foot projecting from the upper body (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B), and a tab extending from the first arm, the tab running in a direction parallel to a second axis of the first molding profile, wherein the first and second axes are substantially perpendicular. The second molding profile (90,95,1000) comprises a groove (91), wherein the groove (91) receives the tab (180), thereby attaching the first and second molding profiles together. While

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Kornfalt et al. does not disclose that the groove extends into the first arm and the tab extends along the second molding profile, it would have been obvious to one having ordinary skill in the art at the same time the invention was made to form a groove extending into the first arm and a tab on the second molding, as it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstien, 8 USPQ 167.

d. Regarding claim 20, Kornfalt et al. discloses a method of assembling a molding profile assembly that includes a first molding profile (100,101,102,103) and a second molding profile (90,95). The method comprises receiving a tab in a groove, wherein the first molding profile (100,102,103) includes a first arm and a second arm (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B). While Kornfalt et al. discloses a groove (91) located in the second molding profile and the tab is associated with the first arm, it would have been obvious to one having ordinary skill in the art at the same time the invention was made to form the groove in the first arm and the tab in association with the second molding profile, as it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstien, 8 USPQ 167.

e. Regarding claim 21, the method further comprises sliding the tab (1800) through the groove (paragraph 51).

f. Regarding claim 22, the method further comprises snapping the tab (1801) into the groove (paragraph 52).

- g. Regarding claim 23, Kornfalt et al. discloses a molding profile for use between two building surfaces, comprising an upper body portion made of wood (paragraph 40) having a first arm and a second arm extending in opposite along a first axis of the molding profile (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B) and a foot projection from the upper body portion along a second axis of the molding profile (paragraph 18; Figs. 5,6A, 10B, 11B, 12B, 14B), wherein the first axis and the second axis are substantially perpendicular. Kornfalt et al. does not disclose a first groove extending into the first arm. However, Kornfalt et al. does disclose a tab, extending out of the first arm, which interlocks with a groove in a second molding profile. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to form a first groove extending into the first arm, as it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstien, 8 USPQ 167.
- h. Regarding claim 24, the molding profile further comprises a surface layer attached to a surface of the upper body portion (paragraph 35).
- i. Regarding claim 25, the surface layer can be a veneer (paragraph 5).
- j. Regarding claim 26, the veneer can be a thin layer of wood, the wood being different from the wood of the upper body portion (paragraph 5).
- k. Regarding claim 27, the surface layer can be a décor paper impregnated with a protective coating (paragraph 15).



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- I. Regarding claim 28, the surface layer can be a veneer that comprises an artificial material (paragraph 13).

***Allowable Subject Matter***

7. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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NAOKO SLACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600